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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF :

NARINOBU KAGAMI, ET AL. : EXAMINER: NGUYEN, C.

SERIAL NO: 09/868,628 :

FILED: JUNE 26, 2001 : GROUP ART UNIT: 1754

FOR: HYDROGENATION CATALYST FOR HYDROCARBON OIL, CARRIER FOR IT, AND METHOD OF HYDROGENATION OF HYDROCARBON OIL :

RESPONSE TO REQUIREMENT FOR RESTRICTION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Official Action of September 8, 2003, Applicants elect, with traverse, Group I, Claims 1-8, 10-21, 34-38, and 40-51, drawn to a hydrogenation catalyst and its method of production.

Remarks begin on page 2 of this paper.

REMARKS

The Office has required restriction in the present application as follows:

Group I: Claims 1-8, 10-21, 34-38, and 40-51, drawn to a hydrogenation catalyst and its method for production;

Group II: Claims 23-32 and 52-58, drawn to a carrier and its method for production; and

Group III: Claims 9, 22, 33, 39, and 59, drawn to a method of hydro-desulphurization of hydrocarbons.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP § 803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

This application is a 371 of International Application PCT/JP00/07276, filed October 19, 2000, and is therefore properly subject to restriction only under the PCT rules. As noted in MPEP § 1895.01(D), restriction practice under 35 U.S.C. § 121, as it applies to national applications submitted under 35 U.S.C. § 111(a), is not applicable to a national stage application such as this one. Applicants respectfully note that the PCT administrative instructions in MPEP, Annex B, Part 1, provide direction on restriction practice under the PCT rules. The Office has not made a proper case of restriction under the PCT rules, and therefore the requirement for restriction should be withdrawn.

Moreover, MPEP § 803 states:

"If search an examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

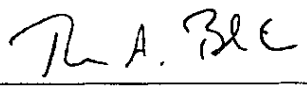
Applicants respectfully submit that a search of all the claims would not pose a serious burden on the Office.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain a requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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